

REMARKS

Reconsideration is respectfully requested. Claims 24-27, 29-36 and 38-43 are pending and stand rejected.

Rejections under 35 USC § 103(a)

The Examiner has rejected claims 24, 30-36, and 38-42 under 35 USC § 103(a) as allegedly being unpatentable over Bamdad et al. U.S. Pat. No. 6,541,617 (hereinafter "Bamdad"). Claim 43 has been rejected under 35 USC § 103(a) as allegedly being unpatentable over Bamdad in view of Duong et al. U.S. Pat. No. 6,740,518 (hereinafter "Duong").

However, under 35 U.S.C. § 103(c)(1) these references may not be properly cited by the Examiner as grounds for an obviousness rejection. 35 U.S.C. § 103(c)(1) states:

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Neither Bamdad nor Duong can preclude patentability of the present invention under 35 U.S.C. § 103. Each reference would only qualify as alleged prior art under 35 U.S.C. § 102(e), (f), or (g) and at the time the present invention was made each reference was either owned by or subject to an obligation of assignment to the Applicants.

The publication date of each reference is the date of issue. Bamdad issued on April 1, 2003 and Duong issued on May 25, 2004. As such, neither is prior art under 35 U.S.C. § 102(a) because both published well after the filing date and priority date of the instant application. Likewise, neither is a prior art reference under 35 U.S.C. § 102(b) the filing date of the instant application is prior to the publication date of each reference. Also, neither reference is a prior art reference under 35 U.S.C. § 102(c) or (d). Therefore, Bamdad and Duong could only be considered as alleged prior art under 35 U.S.C. §§ 102(e), (f), or (g).

In accordance with the requirements to establish common ownership articulated in M.P.E.P. § 706.02(I)(2), the instant U.S. Patent Application No. 09/760,384, the Bamdad patent, and the Duong patent were, at the time the invention of the instant application was made either

owned by or subject to an obligation of assignment to Clinical Micro Sensors, Inc. Therefore, according to U.S.C. § 103(c)(1), Bamdad and Duong cannot preclude patentability of the presently claimed invention under U.S.C. § 103. Because both Bamdad and Duong do not qualify as alleged prior art, Applicants request that the rejections be withdrawn.

CONCLUSION

The present application is therefore in condition for allowance. Early and favorable notification thereof is respectfully requested. If the Examiner believes there are further unresolved issues, the Examiner is invited to call the undersigned at (415) 781-1989.

Respectfully submitted,
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